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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,882	03/18/2004	Shinji Iino	250227US	5195
22850	7590	05/19/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PATEL, PARESH H	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4.9

**Office Action Summary**

Application No.

10/802,882

Applicant(s)

IINO ET AL.

Examiner

Paresh Patel

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/931,888.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Okubo (US 6529011).

Regarding claim 1, Okubo **[in fig. 1 and at lines 19-39 of column 4]** discloses:  
a method for inspecting a target object to be inspected, comprising the step of:

a bringing about a fringing phenomenon **[using 8]** using at least probe in a part of an insulating film formed on an inspection electrode **[2 or 3]** of the target object **[1]** to be inspected so as to break a part of the insulating film **[lines 64-67 of column 3 and 1-4 of column 4]**;

stopping a voltage **[using 6 or 7]** from being applied across the at least one probe and the inspection electrode when a current flowing between the at least one probe and the inspection electrode reaches a reference value **[lines 64-67 of column 3 and 1-4 of column 4]**;

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bringing the at least one probe **[4 or 5]**, used to bring about fritting phenomenon, into electrical contact with the surface of a part of the inspection electrode, the insulating film of the part of the inspection electrode having been broken by fritting phenomenon; and

inspecting the electrical characteristic **[using 9]** of the target object using a tester connected to the at least one probe **[lines 5-16 of column 4]**.

Regarding claim 2, Okubo discloses: breaking a part of the insulating film comprises the step of:

bringing the at least one probe **[4]** into contact with the inspection electrode **[2]**; and

applying a voltage **[using 8]** between the at least one probe and the inspection electrode so as to bring about the fritting phenomenon **[lines 64-67 of column 3 and 1-4 of column 4]**.

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Okubo (US 6529011).

Regarding claim 1, Okubo **[in fig. 3 and at lines 12-48 of column 5]** discloses: a method for inspecting a target object to be inspected, comprising the step of:

a bringing about a fritting phenomenon **[using 8a or 8b]** using at least probe **[(4a or 4b) or (5a or 5b)]** in a part of an insulating film **[oxide or insulation]** formed on an inspection electrode **[2 or 3]** of the target object **[1]** to be inspected so as to break a part of the insulating film **[lines 22-30 of column 5]**;

stopping a voltage **[using 6 or 7]** from being applied across the at least one probe and the inspection electrode when a current flowing between the at least one probe and the inspection electrode reaches a reference value **[1-4 of column 4]**;

bringing the at least one probe **[(4a or 4b) or (5a or 5b)]**, used to bring about fritting phenomenon, into electrical contact with the surface of a part of the inspection electrode, the insulating film of the part of the inspection electrode having been broken by fritting phenomenon; and

inspecting the electrical characteristic **[using 9]** of the target object using a tester connected to the at least one probe **[lines 44-47 of column 5]**.

Regarding claim 2, Okubo discloses: breaking a part of the insulating film comprises the step of:

bringing the at least one probe **[4a]** into contact with the inspection electrode **[2]**;  
and

applying a voltage **[using 8a]** between the at least one probe and the inspection electrode so as to bring about the fritting phenomenon **[lines 22-30 of column 5]**;

Regarding claims 3-4, Okubo discloses: breaking a part of the insulating film comprises the step of:

bringing the at least one probe **[4a]** and a second probe **[4b]** into contact with the inspection electrode; and

applying a voltage **[using 8a]** between the at least one probe and the inspection electrode so as to bring about the fritting phenomenon **[lines 22-30 of column 5]**;

inspecting the electrical characteristic **[using 9]** of the target object to be inspected by utilizing the at least one probe **[4a]** while the second probe **[4b]** remains in contact with the surface of a part of the inspection electrode, the insulating film of the part having been broken by the fritting phenomenon which has been brought about within the insulating film.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

### ***Election/Restrictions***

5. This application contains claims 8-15 drawn to an invention nonelected **without traverse** in Paper No. 08/30/2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 571-272-1968. The examiner can normally be reached on 8:00 to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
May 12, 2005

Paresh Patel  
Primary Examiner  
Art Unit 2829